

REMARKS

By the present Amendment, Claims 1, 2, 13, and 14 have been amended and Claims 21 and 22 have been added. Claims 1-22 are now pending in this application. Applicant respectfully requests reconsideration and withdrawal of the rejections in view of the following remarks.

CLAIM REJECTIONS--35 U.S.C. 112, SECOND PARAGRAPH

Examiner rejected Claim 2, under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Applicant has amended claim 2 to replace the term "frosting sheet" with the term "edible sheet" which is used in the specification. Given the amendment, Applicant respectfully requests that Examiner withdraw the rejection of Claim 2 based on § 112, first paragraph.

Examiner rejected Claims 13 and 14 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, Examiner states that there is insufficient antecedent basis for the limitation "chocolate" in Claims 13 and 14. Applicant has added Claim 21 to provide sufficient antecedent basis for the limitation "chocolate" and amended Claims 13 and 14 to depend from Claim 21. Given the addition of Claims 21 and 22 and the amendments to claims 13 and 14, Applicant respectfully requests that Examiner withdraw the rejections of Claims 13 and 14 based on § 112, second paragraph.

CLAIM REJECTIONS--35 U.S.C. 103

Examiner rejected Claims 1-20 under 35 U.S.C. § 103(a) as being unpatentable over Nakanishi, Food Package. and Shigeo, JP 55034966, in view of Cone, U.S. Patent 5,229,149, Waters, U.S. Patent 6,376,000, Macpherson, U.S. Patent 5, 017,394, and Stewart, U.S. Patent 6,616,958. This rejection is respectfully traversed because the film used in Nakanishi is to be used on water-soluble foodstuffs. (See translation, page 17). In the Office Action, Examiner stated the following:

Nakanishi discloses a method of decorating fruit with a design, comprising of selecting a fruit, selecting a design, printing the design, and attaching the design to the fruit (translation, page 17), as further evidenced by Shigeo (translation, page 2).

(Paper 1 at 3); and

It is conventional in the art to provide coated fruit as evidenced by Cone (column 4, lines 52) and the applicant's admission of prior art. To modify Nakanishi and

print on a conventional coated fruit, rather than a conventional uncoated fruit, would have been an obvious matter of choice.

(Paper 1 at 3).

Neither Nakanishi nor Shigeo in view of Cone provide for attaching a printed design on fruit coated in a water intolerant coating; whereas Applicant's does. The methods of Nakanishi, Shigeo, and Cone are different and, therefore, the limitations of Claims 1- 20 cannot be mere design choices in view of Nakanishi, Shigeo, Cone, or combinations thereof. Examiner has not shown any evidence that the method for printing a design on fruit as disclosed in Nakanishi and Shigeo would allow for a design to be printed on coated fruit.

One of ordinary skill in the art at the time of the invention would not have made the design modifications to the methods of Nakanishi, Shigeo, and Cone as alleged by Examiner.

Cone teaches of coating the fruit with a confectionary coating. Confectionary coatings are well known in the art to be water intolerant. Nakanishi teaches of affixing film on "foods having water content, or when used in foods with almost no water content (dried fruit, F-D foodstuffs, etc.) (translation, page 17). Similarly, Shigeo teaches of pasting a film on uncoated fruits. Both Nakanishi and Shigeo teach of using a water-soluble film. Such a film would not work on a water intolerant coating. As is well known in the art, to use the water based film disclosed in Nakanishi and Shigeo and the printing methods disclosed in Shigeo with the water-intolerant coating in Cone, as the Examiner has suggested would result in the chocolate seizing and becoming thick, lumpy, grainy, or flakey.

Essentially, one of ordinary skill in the art would not be inclined to modify Nakanishi to be able to decorate fruit coated with a water-intolerant coating. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Since Nakanishi or Shigeo in view of Cone have no teaching, suggestion, or motivation for modifying the method of printing an image on uncoated fruit disclosed therein, the rejection lacks proper basis and should be withdrawn.

For the reasons stated above and because Claims 2-18 depend from Claim 1 which should now be deemed allowable, Examiner is respectfully requested to withdraw the rejections made to

Claims 2-18 under 35 U.S.C. § 103. Also, for the reasons stated above, the rejections made to Claims 19 and 20 should be withdrawn.

Examiner rejected Claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Waters, and the admitted prior art in view of Nakanishi and Shigeo. This rejection is respectfully traversed. In the Office Action, Examiner stated the following:

In regards to claim 4, Waters (column 6, lines 49) and the applicant's admission of the prior art disclose the use of an inkjet printer for printing designs onto edible sheets. To use this method to print designs for coated fruit would be obvious, in view of Nakanishi and Shigeo, to provide a quick way of printing and designs and an easy way to reproduce designs without changing the consistency of the coating. (Paper 2 at 3).

Neither Waters, the disclosed prior art, Nakanishi nor Shigeo either alone or in combination disclose Applicant's invention. For the reasons stated above, neither Nakanishi nor Shigeo provide for attaching a printed design on fruit coated in a water intolerant coating. Also, Shigeo teaches away from using an ink jet printer. Shigeo states:

Furthermore, printing in an ink jet method has also been investigated, but despite the fact that expensive printing machines are required in this method, a print image without distortion cannot be obtained.

(Translation, page 3)

One of ordinary skill in the art at the time of the invention would not have been compelled by Shigeo to modify either Waters or the disclosed prior art to create a method for attaching a printed design on fruit coated in a water intolerant coating. Therefore, neither Waters, the disclosed prior art, Nakanishi nor Shigeo are combinable to render obvious Applicants' invention as proffered by Examiner. In view of the above, Applicants respectfully request the Examiner to withdraw the rejection of Claim 4 under 35 U.S.C. § 103.

CONCLUSION

Given the arguments presented above, Applicants submit that Claims 1-22 are now in condition for allowance. Therefore, Applicants respectfully request that Examiner withdraw all rejections to the above-referenced claims. If there are any outstanding issues that the Examiner feels may be resolved by way of a telephone conference, the Examiner is cordially invited to contact Steven B. Leavitt at (972)-412-2671.

Respectfully submitted,

Law Office of Steven B. Leavitt, LLP.
9914 Waterview Parkway
Rowlett, Texas 75089
Phone - (972) 412-2671
Fax - (214) 292-8657

By: 

Steven B. Leavitt
Registration No. 45,318